

REMARKS**Election/Restriction Requirement**

Applicant's attorney confirms the 03-16-2005 telephone conversation with Examiner Garcia and that a provisional election was made without traverse to prosecute the invention of species II, claims 2-5. Claim 1 is canceled; however, Applicant reserves the right to prosecute the subject matter of claim 1 at a later date.

04-07-2005 Telephonic Interview

During the interview the following issues were discussed.

1. Drawings Objection. Applicant advised that MPEP §601.01(f) does not require amendment to the drawings since all pending claims were method claims. The Examiner stated that this rule only pertained to the situation where no drawings were filed with the application. In other words, once drawings were filed, even if unnecessary, then the Examiner could require changes. Applicant stated the invention is not the actual structure of the barrier, but rather the method of use. In this situation, the drawings were submitted to provide illustration as to how the barrier is used rather than how constructed. The Examiner did not withdraw his objection.

2. Claim 2 grammatical changes. Changes to certain phrases were at issue specifically, "the portion" and "a portion". It was agreed that "the portion" was acceptable if "a portion" was changed to "said portion".

3. Claim 4 grammatical changes. The Examiner objected to the use of Velcro® in the claims. Applicant advised that based upon a search of the US Patent Office database use of Velcro® in the claims occurred 1,787 times. The Examiner agreed to permit Applicant to use the term "hook and loop" to replace Velcro®.

4. The term "low profile". Applicant informed the Examiner of support for use of this term in the specification at paragraphs [0005], [0007], [0011], and [0012]. The Examiner was apprised that according to MPEP§2173.05(a), he is encouraged to suggest alternative alternatives that are free from objection. No alternatives were provided and this issue was not resolved.

5. Marshall reference. A discussion of the Marshall prior art reference occurred. No agreement was reached.

6. New claim 6. Discussion of a new claim occurred. No agreement was reached.

The following is Applicant's formal response to the Office Action dated 03-31-2005.

Pending claims 2 and 5 have been amended to more fully describe the invention for avoiding the Marshall reference. New independent claim 6 is also submitted. Claims 2 and 6 include the claim limitation "to create a barrier preventing movement of an infant from one area of a house to another". Applicant believes this added limitation avoids the Marshall reference which will be discussed in greater detail below.

Drawings Objection

The Examiner has objected to the original drawings on the basis of 37 CFR §1.83(a), taking the position that every feature of the invention specified in the claims must be illustrated.

Applicant respectfully disagrees. As support for Applicant's position, each of the original claims submitted are method claims. According to MPEP §601.01(f):

"It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113."

The submitted drawings evidence examples of the method of use Applicant regards as the invention. Structure of the barrier is not the invention since the barrier can be of various designs (see Applicant's specification paragraph [0005]). Drawings are not essential to understand the invention in the context the Examiner suggests. By example, the Examiner takes the position that a drawing must show sheeting material attached to the flooring using Velcro®. Applicant believes one having ordinary skill in the art understands how Velcro® is used in this manner and therefore illustrations are not necessary for an understanding.

For the reasons stated above, Applicant requests the Examiner to reconsider his position and withdraw his objection to the drawings as submitted.

Claim Objections

A. Claim 2: *Changing: "the portion" to: "a portion" and changing: "a portion" to: "the portion"*

The Examiner has objected to the term "the portion" as used at line 11 and requires it be changed to --a portion-- and the term "a portion" found at line 13 be changed to --the portion--. The Examiner has not indicated his reasoning for requiring the change.

Applicant believes usage of "the portion" at line 11 is correct. The pertinent portion of the claim element in claim 2 is: "sizing...of the sheeting material to substantially conform to *the portion* of the floor intended to be placed upon...". As used, *the portion* identifies a particular area of the floor. As defined in Black's Dictionary, the term "the" is a word of limitation as opposed to the generalizing force of "a" or "an". Applicant therefore believes its usage at line 11 is correct.

Based upon the 04-07-2005 interview with the Examiner, Applicant has amended claim 2 from use of the term "a portion" to "said portion". It is believed the objection to claim 2 should now be withdrawn.

B. Claim 4: *Objection to use of the term Velcro®.*

The Examiner has objected to the use of Velcro® in claim 4. The Examiner states that use of trademarks is permissible in patent applications and to this Applicant agrees. However, the Examiner next states that trademark use is not permissible in the claims. This restriction is not found anywhere in the MPEP, nor is there a requirement that the trademark be capitalized if the symbol "®" is used as a source designator. The Examiner states that the proprietary nature of the mark should be respected presumably citing passages from MPEP 608.01(v). However, this is precisely what Applicant has done by utilizing the "®" to designate the proprietary nature of Velcro as a registered trademark in the United States.

A search of the patent database for use of the term "Velcro" in patent claims issued since 1976 was conducted. The search identified 1,787 patents which use the term "Velcro" in claims. A copy of the first page of the search is provided which identifies the most recent 22 patents using "Velcro" in claims. (Exhibit A).

Although Velcro has been used by hundreds of patentees without objection from previous PTO examiners, Applicant agreed to amend claim 4 to replace the term "Velcro®" with the Examiner's suggestion "hook and loop". It is to be understood that Applicant considers both terms to be interchangeable and that "hook and loop" is considered to be equivalent structure to Velcro®. In view of this amendment to claim 4 and to the newly submitted claims 8 and 10, it is believed the objection should be withdrawn. However, Applicant reserves the right to resubmit dependent claims using Velcro® should it become necessary to file an appeal.

Claim Rejections

A. Rejection based upon 35 USC §112, second paragraph

The Examiner has rejected pending claims 2-5, contending the term "low-profile" is a relative term rendering the claim indefinite. The Examiner states the term "low-profile" is not defined by the claim. Respectfully, a term is not required to be defined in a claim. Were this the rule, claims would be excessively long since each and every term would have to be defined.

The Examiner next states: "the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In other words, what is considered low-profile?"

To answer the Examiner's inquiry, one need only refer to the specification. The term "low profile" is discussed in the specification as follows:

In paragraph [0005], "Finally, the barrier must be low-profile to prevent the infant from being able to grab or remove certain portions of the barrier in its entirety."

In paragraph [0007], "The barrier is designed to have a low profile so that adults and older children will have no difficulty stepping across or reaching over."

In paragraph [0011], "The upward extending section design has a low profile so that it is difficult for an infant to grab and detach or to cause injury if fallen upon. Therefore, the substantially upward extending section is of a very short length. The low profile and barrier configuration permits adults to walk over the barrier with no difficulty."

In paragraph [0012], "In sum, the barrier should be designed so that contact with the stud or alternative design to the stud will result in temporary discomfort but not cause injury."

From these paragraphs, one with ordinary skill in the art would easily ascertain that the term "low-profile" is such that: a) the upward extending sections can not be grabbed and removed by an infant; b) is short enough in height to permit adults and older children to step across or reach over with no difficulty; and, c) will result in temporary discomfort but not cause injury to an infant.

During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. MPEP§2173.05(a) citing *In re Morris*, 127 F.3d 1048, 1054; 44 USPQ 2d 1023, 1027 (Fed.Cir. 1997). If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more. MPEP§2173.05(a) citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F2d. 613; 225 USPQ 634 (Fed. Cir. 1985). Finally, if the proposed language is not considered as precise as the subject matter permits, the Examiner should provide reasons to support the conclusion of indefiniteness and *is encouraged to suggest alternatives that are free from objection*. MPEP§2173.05(a).

Applicant believes the language of the claim is as precise as the subject matter permits. One having ordinary skill in the art would readily understand that the invention is a method of using a sheeting material to form a barrier preventing movement of a child from one area to another. The sheeting material is sized sufficiently narrow and short in height (i.e. low-profile) to allow older children and adults to normally stride across and not have to contact the sheeting

while, at the same time, being sufficiently broad to discourage an infant from attempting to cross. Should the infant attempt to cross, the sheeting material has upward extending members of a very short length which will cause the infant to experience temporary discomfort when an extending member is touched and weight applied.

Applicant believes the foregoing is within the parameters set forth by the holding in *Shatterproof Glass Corp.* Accordingly, on the basis of the submitted argument, Applicant respectfully requests the Examiner to withdraw his rejection of claims 2-5 on the basis of 35 USC §112, second paragraph, or in the alternative, suggest alternatives that are free from objection under MPEP§2173.05(a).

B. Rejection based upon 35 USC §102

The Examiner has rejected claims 2-5 on the basis of US Pat. No. 4,431,166 issued to Marshall. Marshall discloses a garbage can mat (i.e. a circular mat surrounding a garbage can in the center) having upward extending spikes designed to be driven into the area between a dog's paw pads and cause the dog great pain if a dog were to stand upon the mat. (Col. 3, lines 56-59). The spikes are designed of a length of 1.5 inches, spaced 1 inch apart. (Col. 4, lines 12-15). This length and spacing are necessary so the spikes have sufficient length to extend past the paw pads and reach the soft tissue lying between.

Marshall does not teach or suggest using its disclosed garbage can mat as a method for preventing movement of an infant from one area of a house to another by creating a barrier on a floor. As used in Marshall, the term "mat" is a structure for standing upon. It is necessary for someone to stand upon the mat in order to reach the center and dispose of trash in the garbage can. If the diameter of the mat were smaller so a child or adult could reach across and dispose of trash in the garbage can, then it would be possible for a large dog to likewise stand on his hind legs and avoid the mat and still knock over the garbage can which is contrary to what Marshall teaches.

Applicant's method is unique in that the sheeting material need only be of a sufficiently narrow width to deter an infant from crossing. Claim 6 has the limitation "said sheeting material sized for older children and adults to step over while still providing sufficient depth to

discourage an infant from attempting to cross". Given the motor skill possessed by an infant, that width is substantially less than the normal walking stride of an older child and adult. Therefore, it is not necessary that the sheeling material be sufficiently wide so *everyone* must step upon it in order to function as a barrier to an infant. By contrast, this is precisely what Marshall teaches, i.e. a mat to step upon.

The mat described in the Marshall reference is not designed for adults to step across; rather, it is designed for adults to stand upon and also to prevent large dogs capable of knocking over a garbage can from standing upon the mat.

If Applicant's low profile barrier were applied to the garbage can mat, the upward extending spikes would not be sufficiently long to extend past the paw pads and reach up to the sensitive tissue of a dog's paw. In other words, a large dog would not be deterred by Applicant's low profile barrier if it wanted to knock over a garbage can. It would step upon the barrier, being protected by its paw pads.

The Examiner must concur that infants do not possess paw pads. Therefore, the height of the upward extending sections required to provide temporary discomfort to an infant is substantially less than what is necessary in the Marshall reference. It is improper for the Examiner to hold that the height limitation is irrelevant in view of Marshall because Marshall requires a height sufficient to extend past paw pads while the pending application discourages such a height because of the potential for injury.

Applicant is aware that Marshall states: "The mat is safe as no injury to children or adults will result from their walking or falling on it as there are no sharp edges or projections..." (Col 4, lines 59-62). This broad conclusory statement standing alone should not be considered evidence. *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Applicant believes this statement can not be reasonably applied to infants because if an infant were to fall upon a plurality of spikes 1.5 inches in height spaced 1 inch apart, that infant, were it to fall on its head, would risk serious injury particularly if the impact were to be around the eye areas.

To summarize, elongated spikes approximately 1.5 inch in height are necessary in Marshall to deliver the intended pain to a large dog, while an infant has no paw pads requiring

such a lengthy spike for causing discomfort. However, a spike as disclosed in Marshall, is certainly capable of causing injury to an infant and a basic premise of Applicant's invention is that the elongated members be of low profile to avoid injury. Applicant states that the spikes disclosed in Marshall are not considered to be low profile as this term is used in the pending application.

For these reasons, the Marshall reference can not anticipate Applicant's invention.

CONCLUSION

Applicant believes each of the Examiner's objections and rejections have been properly addressed and respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Results of Search in 1976 to present db for:

ACLM/velcro: 1787 patents.

Hits 1 through 50 out of 1787

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PAT. NO.	Title
1 6,869,127	T Temporary replacement window
2 6,866,618	T Office exercise device
3 6,862,827	T Holder for displaying travel related documents
4 6,858,036	T Device for acupuncture
5 6,852,021	T Implement for abrading and method of making same
6 6,846,083	T TV screen cover
7 6,840,238	T Assembly for fixing a tube for medical purposes to a patient's mouth
8 6,840,003	T Light emitting insect trap
9 6,837,191	T Pet diaper garment
10 6,837,185	T Religious meditation apparatus
11 6,834,773	T Tissue dispenser
12 6,828,500	T Ventilating battery cover
13 6,827,653	T Wrist support for bowlers
14 6,823,864	T Nasal support device for domestic mammals and method
15 6,820,639	T Thermal cover for backflow prevention assemblies
16 6,814,408	T Folding chair equipped with inflatable waist pad
17 6,808,149	T Hands-free wall mounted bottle holder
18 6,807,696	T Device for adjusting the position of a cushion relative to a mattress or sitting surface
19 6,805,453	T Medical instrument arrangement with drape
20 6,805,237	T Blueprint caddy
21 6,796,873	T Structure of a toy car
22 6,796,425	T Garment holder